

REMARKS

This amendment is in response to the Official Action mailed March 10, 2004.

In the present paper, claims 1-18, 23-27 and 37-40 are cancelled (claims 19-22 having been canceled in a previous paper). Claims 41-68 are added in the present paper. Claims 28-36 and 41-68 are presented for the Examiner's consideration in view of the following remarks.

*The Present Application*

The present application is directed to a system and method for modifying the operation of a personal communication device in a vehicle. A large number of states have passed regulations governing the use of cell phones in vehicles. The present invention provides a technique for enforcing compliance, or for reminding cell phone users of the law as those users enter new jurisdictions. In general, the method of the invention involves determining the location of the cell phone and whether it is being used in a vehicle, assessing the laws governing that jurisdiction, and deducing whether there are any restrictions imposed on cell phone use. In various embodiments, the vehicular cell phone user may be reminded of the restrictions, or the restrictions may be enforced by, for example, refusing service on the cell phone.

Independent claim 28 of the present application is directed to a method for controlling the use of at least one personal communications device in a vehicle. The method includes the steps of, at a controller in the vehicle, deriving information relating to the geographic location of the vehicle, and, at the controller in the vehicle, deriving information relating to restrictions on the use of personal communications devices in at least one geographic region. The method also includes, at the controller in the vehicle, determining whether the geographic location of the vehicle bears a predetermined relationship to at least one of the geographic regions, and

transmitting a message from the controller in the vehicle to the at least one personal communications device imposing restrictions on use of each of the personal communications devices while the predetermined relationship exists.

The method of claim 28 utilizes a controller in the vehicle. By doing so, much of the functionality necessary for performing the method of the invention is shifted to the vehicle, reducing the functional requirements of the portable communications device. That is important in cases where the weight and expense of the communications device are an issue. Further, some functionality, such as a GPS positioning system, may already be included in the vehicle design. Finally, additional input from the vehicle itself, such as vehicle speed and the use of a reverse gear, are available to an in-vehicle system. A complete discussion of that system may be found in the present specification at page 18, line 23 – page 21, line 21.

New independent claim 41 of the present application is directed to a method for controlling the use of a wireless personal communications device in a vehicle. The method includes the initial step of deriving information relating to the geographic location of the personal communications device.

Information is then derived relating to restrictions on the in-vehicle use of personal communications devices in each of a plurality of geographic regions, and it is determined whether the geographic location of the personal communications device bears a predetermined relationship to at least one of said geographic regions. It is next determined whether the personal wireless communications device is being used in a vehicle. Restrictions on the in-vehicle use of the personal communications device while the predetermined relationship exists are determined.

The method of new claim 41 is an important advance over the prior art because it permits controlling the in-vehicle use of a cell phone or other communications device according to local

law, without restricting non-vehicle use. The new claims are fully supported by the specification.

The Examiner has rejected all the claims previously presented in the application under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2004/0033795 to Walsh et al. (Walsh) in view of U.S. Patent No. 6,470,447 to Lambert et al. (Lambert).

*The Walsh Patent Application*

Walsh is directed to a location information system for use with a “911” emergency communication system. Walsh discloses in FIG. 2 a location information system whereby a plurality of wireless communication units 206-209 broadcast location information for predetermined areas in a facility such as floors, rooms, hallways, stairways and elevators (Walsh, [0055] – [0056]).

The Examiner states that Walsh, at paragraph [0022], discloses “a method for controlling the use of a wireless personal communications device in a vehicle.” Applicant respectfully submits that Walsh, at most, discloses “in-vehicle” user operation as a mode of operation that may skew location data. Walsh nowhere discloses controlling a device in a vehicle.

*The Lambert Patent*

Lambert teaches a technique for dynamically controlling the encryption parameters used by a mobile device to ensure conformance to the cryptographic requirements of various countries. Based on local legislation, the system can change the cryptography characteristics or key, break the connection or disable the device (Lambert, col. 8, lines 58-64).

***Discussion***

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03 (*citing In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

**CLAIMS 28-36**

Applicant respectfully submits that in the case of independent claim 28, the Examiner has not established a *prima facie* case of obviousness because the combination made by the Examiner fails to teach the use of a controller in a vehicle as claimed.

The Examiner alleges that Walsh, at paragraph [0022], discloses “a method for controlling the use of at least one personal communications device in a vehicle.” In fact, as noted above, that passage simply states that “in-vehicle” user operation may skew location data. That passage in no way suggests controlling a personal communications device in a vehicle. Further, that passage is the ONLY mention of any vehicle in the Walsh disclosure.

The Examiner further alleges that Walsh at paragraph [0056] discloses “at a controller in said vehicle, deriving information relating to the geographic location of said vehicle.” Applicant respectfully submits that Walsh makes no mention of a vehicle at paragraph [0056]. Nowhere does Walsh teach or suggest a controller in a vehicle.

As noted by the Examiner, Walsh contains no disclosure of the “restrictions” limitations of claim 28. The Examiner, however, alleges that Lambert, at col. 8, lines 23-33 & col. 11, lines 15-22 teaches the following limitations of claim 28:

at said controller in said vehicle, deriving information  
relating to restrictions on the use of personal communications  
devices in at least one geographic region,

at said controller in said vehicle, determining whether said geographic location of said vehicle bears a predetermined relationship to at least one of said geographic regions, transmitting a message from said controller in said vehicle to said at least one personal communications device imposing restrictions on use of each said personal communications device while said predetermined relationship exists.

Initially, Applicant submits that the last step of the method, requiring that a message be transmitted from the controller in the vehicle to the personal communications device, requires that the steps be performed by two different elements: a controller in the vehicle and a personal communications device. Otherwise, a “transmitting” step would not have meaning.

Lambert nowhere discloses a controller in a vehicle that performs the claimed functions and transmits a message imposing restrictions to a personal communications device. That feature of the present invention ensures that the restrictions on communication device use are not applied to devices not used in vehicles. Nowhere in the art of record is a controller in a vehicle used to determine location and to transmit restrictions to a communication device.

Furthermore, as noted above, by separating the functions performed by the controller in the vehicle from the personal communications device, much of the functionality necessary for performing the method of the invention is shifted to the vehicle. Those functions are unnecessary in a communications device that is not used in a vehicle, because the functions relate to legislation restricting the use of a communications device in a vehicle.

Applicant therefore respectfully submits that claim 28 is patentable over the cited references, and that claims 29-36, which depend on claim 28 and incorporate its limitations, are patentable for the same reasons.

## CLAIMS 41-68

New claim 41 contains all the limitations of original claim 1, with the restrictions being for in-vehicle use of a personal communications device. In addition, new claim 41 requires the step of:

determining whether the personal wireless communications device is being used in a vehicle.

Applicant submits that none of the art of record teaches or suggests that such a determination be made. By including a determination that the device is in a vehicle, the inventors have discovered a technique for avoiding inappropriate restrictions on cell phone use, such as restricting use of a device by a person walking near a highway.

Applicant respectfully submits that independent claim 41 and dependent claims 42-68 are patentable for at least that reason.

New claim 42 additionally requires that the determination of whether the personal wireless communications device is being used in a vehicle includes receiving in the personal communications device information transmitted from a controller in the vehicle. Applicant submits that claim 42 is therefore patentable for those additional reasons discussed above with respect to claim 28.

## *Conclusion*

Because the cited references do not teach all the elements contained in the amended claims, Applicant submits that all of the claims are patentable over the combination made by the

Examiner. Applicant therefore asserts that claims 28-36 and 41-68 are now in condition for allowance, and Applicant earnestly requests that the Examiner issue a Notice of Allowance.

Should the Examiner have any questions regarding the present case, the Examiner should not hesitate to contact the undersigned at the number provided below.

Respectfully,

By



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